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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/698,905 | 10/27/2000 | Patrick D. McDonald | 00,500 | 8219 |
| 32097 | 7590 | 03/11/2004 | EXAMINER | |
| LESAVICH HIGH-TECH LAW GROUP, P.C. SUITE 325 39 S. LASALLE STREET CHICAGO, IL 60603 | | | THOMPSON JR, FOREST | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3625 | |

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|---------------------------------|--------------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/698,905 | MCDONALD, PATRICK D. <i>SN</i> |
| | Examiner Forest Thompson Jr. | Art Unit 3625 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 October 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (See Paper #4). The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.

2. This action is responsive to the amendment A filed on 12/05/2003 (see Paper #5). Applicant presented arguments in response to Paper #4. Claims 1-26 are pending.

3. Claims 1-26 have been examined.

Claim Rejections - 35 USC § 102

4. Claims 1-7, 10-11 and 25-26 were rejected in Paper #4 under 35 U.S.C. 102(b) as being anticipated by "User's Guide, Borland Paradox for Windows;" Borland International, Inc.; v5.0; 1994 (hereafter referred to as Paradox). The rejection is repeated below.

Claims 1-7, 10-11, 25-26: Paradox discloses:

- obtaining information from other organizations (i.e., a plurality of repositories) (pg. 268-275), through the functionality of identifying information output by filename from another source and its format. Paradox specifically teaches acquiring data from a plurality of databases (pg. 269-270) and storing the imported data in a database.

Paradox also specifically teaches importing data from delimited text files (i.e., a typical type of file used to unload data from other databases and transfer the data to a Paradox database) (pg. 271-272). The feature of *periodically* obtaining information from a plurality of repositories is encompassed in the disclosure of Paradox providing the user with specific capabilities to import data from files that may use any one of several formats to store data. While no specific time period is defined in Paradox for obtaining data from other databases, Paradox does teach that, *if you want to import data from a delimited text file, choose the file you want in the File Import dialog box, and choose <Delimited Text> from the File Type drop-down list. Paradox opens the Delimited ASCII Import dialog box, shown in Figure 10.10.* (pg. 271) This disclosure encompasses the feature of obtaining data at times consistent with user requirements.

- transforming the plurality of information maintained in a plurality of formats into a unified database format, thereby creating transformed information (pg. 268-275);
- automatically processing forms (pg. 152);
- creating a plurality of database records in a database with transformed information using the unified database format (pg. 268-275);
- extracting selected information from the plurality of formats (pg. 268-275), through the functionality of editing and selecting the information in a file to be imported;
- storing the selected information in a database (pg. 268-275);
- deleting duplicate or incomplete entries (pg.256-258);
- creating a database record (pg. 151-153);
- linking the database record with other database records (pg. 308-312);

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- reading a database record (pg. 107-110);
- processing information from paper documents, microfiche, CD-ROMs, or computer tapes (pg. 268-275);
- combining two or more information fields into one information field (pg. 218-219; pg. 409-411);
- electronically linking selected ones of the plurality of database records in the database to original information from the plurality of repositories (pg. 268-275; pg. 308-312), that is disclosed through the functionality of providing a link/reference to the original data file created from the data obtained from a data source;

Claim Rejections - 35 USC § 103

5. Claims 8-9 and 12-24 were rejected in Paper #4 under 35 U.S.C. 103(a) as being unpatentable over "User's Guide, Borland Paradox for Windows;" Borland International, Inc.; v5.0; 1994 (hereafter referred to as Paradox) as applied to claim 1 above, and further in view of Official Notice. The rejection is repeated below, with some clarification for Official Notice taken by examiner, as requested by applicant in Paper #5.

Claims 8-9, 12-18: Paradox does not specifically disclose create a plurality of pass-through database records; reading the database information to determine contact information relative to the database information; using the contact information to provide notifications; electronically collecting appropriate information required by one or more service providers (e.g., unclaimed property repositories) to disburse unclaimed property;

nor electronically collecting a fee. However, Official Notice is taken that it was old and well known in the art at the time the invention was made that links (linking addresses) could be used as data entries in a database to automatically link to and draw data from the referenced database for the purpose of efficiency/economy of database operations and database space utilization. The link data would be a data entry equivalent to any other, but utilizing a particular format for functional purposes. One example of prior art is Guha (U.S. Patent No. 6,081,805) that teaches (col. 4 lines 27-45):

FIG. 2 is block diagram illustrating a database pass-through architecture in accordance with the-present invention. The database pass-through architecture 70 includes application software 72 for receiving queries from a user 74, and a number of information sources 76 for providing information in response to the queries. As described above, the application software 72 may include a DBMS or an Internet search service, and the data sources may include database tables or Internet search engines, for example.

In accordance with the present invention, the database pass through architecture 70 includes pass-through software 78 that acts as an interface between the application software 72 and the information sources 76. The pass-through software 78 first passes user queries 80 from the application software 72 to the data sources 76. The pass-through software 78 then receives the results of the query and removes duplicates using a hashing technique that eliminates the need to store all the returned results, as described with reference to FIG. 3. Guha teaches the functionality of creating a plurality of pass-through database records, reading the database information to determine contact information relative to the database information, using the contact information to provide notifications, and

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electronically collecting appropriate information required by one or more service providers.

Additionally, Official Notice is taken that it was old and well known in the art at the time the invention was made that contact information may be obtained and stored by service providers in a database with other data for the purpose of communicating status and other pertinent information to the contacts, and charging a fee for the service of communicating such data. An example is buyer information for buyers who buy products through on-line or on-site sales and pay electronically (e.g., by providing credit card information). This information is often used for payment processing, warranty validation, delivery notification, and/or communication processing for other purposes. Also, service providers typically charge fees for the services that they perform. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Paradox to specifically create a plurality of pass-through database records, read the database information to determine contact information relative to the database information, use the contact information to provide notifications, electronically collecting appropriate information required by one or more service providers (e.g., unclaimed property repositories) to disburse unclaimed property, and electronically collecting a fee, as disclosed by old and well known art and Guha, for the motivation of acquiring unclaimed property information and automatically requesting disbursement of unclaimed property.

Claim 19-20: Paradox discloses:

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- providing a graphical user interface (pg. 508-525), which is disclosed through the functionality of creating and using graphs;
- electronically collecting appropriate information;
- automatically processing forms using the collected information;

Additionally, Official Notice is taken that delivery of the property or product when forms/applications/purchase agreements are (electronically or manually) completed was old and well known in the art at the time the invention was made and encompasses the feature of automatically requesting disbursement to the identified owner at that time.

On-line service providers fulfill their agreements when their requirements are met (e.g., payment is provided). And, the forms stored in a database can be used to automatically draw pertinent data from the database when the forms are used, based on query routines stored and used by the database user. For example, Pallakoff (U.S. Patent No. 6,269,343) states *In a situation where offers are accepted (block 37) the buyers' credit cards are charged, the product is shipped to the buyers, and commissions are calculated and paid* (col. 5 lines 38-40). This encompasses applicant's claim language. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Paradox to specifically disclose disbursing or delivering the property or product (e.g., unclaimed property) when forms/applications/purchase agreements are completed, as disclosed by Pallakoff and old and well known art, for the motivation of automatically requesting disbursement of unclaimed property.

Claim 21: Paradox discloses data includes any data the user wants to insert from internal or external data sources (253-256). This data may include only specific information required by the one or more unclaimed property repositories to recover unclaimed property.

Claim 22: Paradox discloses collecting data via a form written in Hyper Text Markup Language or extensible Markup Language or the type of input form and presented to an owner of unclaimed property via the Internet (pg. 152).

Claim 23: Paradox does not specifically disclose the fee is electronically collected automatically for a credit card, debit card, or electronically deducted from a checking or savings account. However, Official Notice is taken that it was old and well known in the art at the time the invention was made that fees could be electronically collected automatically for a credit card, debit card, or electronically deducted from a checking or savings account by on-line service providers. This facilitates rapid transaction verification and completion for the on-line service provider. For example, Pallakoff (U.S. Patent No. 6,269,343) states *In a situation where offers are accepted (block 37) the buyers' credit cards are charged, the product is shipped to the buyers, and commissions are calculated and paid* (col. 5 lines 38-40). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the disclosure of Paradox specifically electronically collect the fee automatically for a credit card, debit card, or electronically deducted from a checking or savings account, as disclosed by old

and well known art and Pallakoff, for the motivation of automatically requesting disbursement of unclaimed property.

Claim 24: Paradox discloses automatically collecting and displaying input forms to collect appropriate information based on an identifier (pg. 31-32), as illustrated by selecting records based on customer number.

Response to Arguments

A. **Applicant argues**, on pg. 2-5 and 7-10 of Paper #5, that Paradox does not teach the identical invention including at least the claim element of periodically obtaining unclaimed property information from a plurality of unclaimed property repositories. Thus, Paradox cannot anticipate the claimed invention under the holding of Richardson. Therefore, examiner has not made a *prima facia* case of anticipation under 35 USC 102(b) and the applicant need not respond any further.

Examiner disagrees. Examiner asserts that the claimed feature of *unclaimed property* information does not add patentable weight to applicant's invention. The database presented by applicant's claims does not specifically limit the concept of a database to exclude that presented by paradox. Paradox teaches a database that may be used to hold data of many different formats, as desired by the database user, and encompasses the category of *unclaimed property* information, as well as other categories. Examiner asserts that no structure has been claimed by applicant that distinguishes the instant invention from many other databases, including Paradox. Applicants' arguments that

paradox was developed as a general database tool and does not encompass applicants' invention are not accepted by examiner. Paradox specifically teaches acquiring data from a plurality of databases (pg. 269-270) and storing the imported data in a database. Paradox also specifically teaches importing data from delimited text files (i.e., a typical type of file used to unload data from other databases and transfer the data to a Paradox database) (pg. 271-272). The feature of *periodically* obtaining information from a plurality of repositories is encompassed in the disclosure of Paradox providing the user with specific capabilities to import data from files that may use any one of several formats to store data. While no specific time period is defined in Paradox for obtaining data from other databases, Paradox does teach that, *if you want to import data from a delimited text file, choose the file you want in the File Import dialog box, and choose <Delimited Text> from the File Type drop-down list. Paradox opens the Delimited ASCII Import dialog box, shown in Figure 10.10.* (pg. 271) This disclosure encompasses the feature of obtaining data at times consistent with user requirements.

Therefore, Examiner maintains the rejection.

B. **Applicant argues**, at pg. 6, that the Application teaches the unclaimed property information is maintained in multiple formats by the unclaimed property repositories including: (1) CD-ROMS; (2) computer tapes; (3) other computer readable formats; and (4) a variety of paper or other types of documents including microfiche. . . . Thus Paradox, even if it could be programmed to execute the steps of the claimed method, which it apparently can not, it does not teach all of the features of the claimed invention

and teaches explicit limitations for processing data not present in the claimed inventions. Therefore, Paradox based its explicit teachings cited by the examiner cannot anticipate the claimed invention.

Examiner disagrees. Paradox teaches databases that encompass a plurality of formats (pg. 269-270). Applicant claims:

- (in claim 1) *obtaining periodically a plurality of unclaimed property information from a plurality of unclaimed property repositories, wherein the plurality of unclaimed property information is maintained in a plurality of formats by the plurality of unclaimed property repositories. . .*
- (in claim 4) *wherein the step of transforming the plurality of unclaimed property information maintained in the plurality of formats into a unified database includes processing unclaimed property information from paper documents, microfiche, CD-ROMS, or computer tapes.*

Examiner asserts that Paradox teaches these specific aspects. In addition to the disclosures presented in the above paragraphs, Paradox also teaches the use of various formats for the presentation of data for loading databases that encompasses at least some of the plurality of formats claimed by applicant (see section A above).

Therefore, Examiner maintains the rejection.

C. **Applicant argues**, at pg. 6-7, that the Applicant is claiming various methods and systems for obtaining and processing unclaimed property information that include various claim limitations that include database functionality. However, the Applicant is

not trying to claim a general database tool such as that described by Paradox as the Examiner is suggesting. . . . Paradox does not teach each and every element as set forth in the claimed invention either expressly or inherently. Thus Paradox cannot anticipate the claimed invention. Therefore, the Applicant now requests the Examiner immediately withdraw the 102(b) rejections with respect to claims 1-7, 10-11, and 25-26.

Examiner disagrees. As stated by Examiner in the sections A and B above, Paradox does teach an invention that encompasses the claimed aspects of applicant's instant invention.

Therefore, Examiner maintains the rejection.

D. **Applicant argues**, at pg. 7-10, that Paradox does not teach or suggest all of the claim limitations, because Paradox as a database tool, does *not teach or suggest, or even mention* at least the method step of periodically obtaining of unclaimed property information from a plurality of unclaimed property repositories or the claim words unclaimed property information at all. Thus, Claim 1 cannot be obvious in view of Paradox.

Claims 8-9 dependent claims, depending on independent Claim 1. These claims add additional limitations not present in Claim 1, but include the limitations of Claim 1 with respect to the method step and references to unclaimed property information. The Examiner is reminded that if an independent claim is nonobvious under 35 USC 103, then any claim depending there from is non-obvious In re Fine 837 F.2d 1071 (Fed. Cir. 1988).

The Applicant has clearly pointed out why Independent Claim 1 is not obvious (or anticipated) Claims 8 and 9 are not obvious. Thus, the Examiner has failed to establish prima facie obviousness based on the holding of *In re Royka*, *In re Wilson* and *In re Fine*.

Examiner disagrees. As presented above, examiner has identified specific teachings of Paradox in sections A and B above that encompass applicants' claimed aspects.

Therefore, examiner maintains the rejection.

E. **Applicant argues**, on pg. 10-11, that, since Paradox was developed as a general database tool for use for many different purposes, modifying Paradox to specifically include obtaining and processing unclaimed property information would render Paradox unsatisfactory for one of its intended purposes of being a general database tool and not a specifically focused database tool.

Examiner disagrees. Paradox was developed as a general database tool for use for many different purposes. However, applicant's claim of the uniqueness of unclaimed property information is not accepted by examiner as a limitation on the use of Paradox. The unclaimed property information as claimed is consistent with data that Paradox can manipulate and store, and does not contribute to the patentability of applicant's invention, as examiner has previously stated in section A above.

Therefore, examiner maintains the rejection.

F. **Applicant argues**, on pg. 11-12, that, since the Applicant has pointed out errors in the Examiner's Official Notice assertion, the Examiner must now provide documentary

evidence to support the Official Notice in the next Office Action if the rejection is to be maintained under the holding of *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

Applicant specifically requests the Examiner provide documentary evidence as to why a general database tool like Paradox would be modified to specifically include obtaining and processing unclaimed property information with the specific limitations and features as recited by the claimed invention.

Examiner responds that unclaimed property information does not provide patentability to applicant's invention (see section A above); in other words, neither the intended use of a database nor the specific information that it contains necessarily provides patentability of the database. Also, as discussed in several of the sections above, Paradox provides database structure and capabilities that encompass applicant's claimed aspects. Modification of Paradox is unnecessary. Paradox users do not modify the Paradox invention. Rather, the users select parameters and features of the Paradox invention that satisfy their goals, needs and objectives for a database when defining/specifying the features of their particular database requirements.

Additionally, per applicant's request for a reference to support the Official Notice

taken in the First Action, examiner presents Guha (U.S. Patent No. 6,081,805) that teaches:

FIG. 2 is block diagram illustrating a database pass-through architecture in accordance with the present invention. The database pass-through architecture 70 includes application software 72 for receiving queries from a user 74, and a number of information sources 76 for providing information in response to the queries. As described above, the application software 72 may include a DBMS or an Internet search service, and the data sources may include database tables or Internet search engines, for example.

In accordance with the present invention, the database pass through architecture 70 includes pass-through software 78 that acts as an interface between the application software 72 and the information sources 76. The pass-through software 78 first passes user queries 80 from the application software 72 to the data sources 76. The pass-through software 78 then receives the results of the query and removes duplicates using a hashing technique that eliminates the need to store all the returned results, as described with reference to FIG. 3.

Guha teaches the functionality of creating a plurality of pass-through database records, reading the database information to determine contact information relative to the database information, using the contact information to provide notifications, and electronically collecting appropriate information required by one or more service providers.

Therefore, examiner maintains the rejection.

G. **Applicant argues**, at pg. 12-17, that, for claims 19-20, since the Applicant has pointed out errors in the Examiner's Office Notice assertion, the Examiner must now provide documentary evidence to support the Official Notice in the next Office Action if the rejection is to be maintained under the holding of *In re Zurko*.

Applicant specifically requests the Examiner provide documentary evidence as to why a general database tool like Paradox would be modified to specifically include automatically requesting disbursement of unclaimed property with the specific limitations and features as recited by the claimed invention. For the reasons stated

above; Claims 19-20 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 19-20.

Examiner disagrees. In support of the Official Notice taken in the First Action, examiner asserts that delivery of the property or product when forms/applications/purchase agreements are (electronically or manually) completed was old and well known in the art at the time the invention was made. One example of this is Pallakoff (U.S. Patent No. 6.269,343) that states *In a situation where offers are accepted (block 37) the buyers' credit cards are charged, the product is shipped to the buyers, and commissions are calculated and paid* (col. 5 lines 38-40). This encompasses applicant's claim language.

Examiner has already addressed applicant's comments and claims about the Paradox database being a general database and it's modification in the above sections, and will not duplicate the responses here. See Examiner's statements in sections A-E above.

Therefore, examiner maintains the rejection.

H. **Applicant argues**, at pg. 15-17, that Paradox was not developed and does not include the recited methods for specifically periodically obtaining and processing unclaimed property information as is recited by the claimed invention, and there can be no motivation to modify Paradox for "automatically requesting disbursement of unclaimed property" as the examiner suggests based on the holding of *In re Gordon*.

Applicant has also requested that the examiner provide documentary evidence as to support the Official Notice "... that fees could be electronically collected automatically for a credit card, debit card, or electronically deducted from a checking or savings account by on-line service providers."

Examiner responds that these arguments have been addressed in sections A, B, D, and G above. Additionally, in response to Applicant's request for documentary evidence, examiner presents Pallakoff (U.S. Patent No. 6.269,343) that states *In a situation where offers are accepted (block 37) the buyers' credit cards are charged, the product is shipped to the buyers, and commissions are calculated and paid* (col. 5 lines 38-40). This disclosure encompasses Applicant's claim language of automatically requesting disbursement of the product through the process of paying for the product..

Therefore, examiner maintains the rejection.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

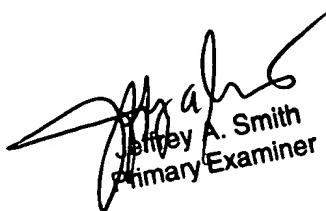
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT 
03/03/04


Jeffrey A. Smith
Primary Examiner